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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,255	10/14/2003	Udi Manber	017887-003610US	7579

20350 7590 02/09/2005

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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,255

Applicant(s)

MANBER ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-28 are pending.

Priority

2. This is a Continuation application 09/510,201 filed on 2/22/2000 now USP 6,651,086.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U. S. Patent No. 6,651,086 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('086) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; receiving a first comment from the first user; presenting the media object and the first comment to a second user such that the first comment and the media object are displayed proximal each other to the second user; receiving a reply comment from the second user responsive to the first comment; presenting the reply comment to the first user, wherein the first and second user are not connected in an instant messaging session; and thereafter if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session.

2. the matching criteria is in the form of an approval indication of the reply comment received from the first user.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments received from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the instant messaging session.

5. the predetermined display count is a function of a parameter settable by the first user.

6. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

7. receiving an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

8. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

9. a plurality of media objects are associated with a concept, and wherein comments received are associated with one of the concept and a specific one of the plurality of media objects.

(Application) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; accepting a first comment from the first user; presenting the media object to a second user along with the first comment; accepting a reply comment from the second user; and if the reply comment fits a matching criteria, connecting the first and the second user in a messaging session.

2. the matching criteria is in the form of an approval indication by the first user of the reply comment.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session.

7. the predetermined display count is a function of a parameter settable by the first user.

8. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

9. accepting an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

10. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

11. a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Barrett et al [Barrett 6,400,381 B1].

5. As per claim 1, Barrett discloses a method, in a messaging server, of connecting parties with mutual interests [Barrett, a chat room, abstract], comprising the steps of:

presenting a media object to a first user [Barrett, a chat window, col 5 lines 15-25];

accepting a first comment from the first user [Barrett, the client applet identifies the user to the chat server, col 5 lines 1-15];

presenting the media object to a second user along with the first comment [Barrett, the documents accessed by a first client computer, col 6 lines 1-27];

accepting a reply comment from the second user [Barrett, accessed by a second client computer, col 6 lines 1-27]; and if the reply comment fits a matching criteria,

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connecting the first and the second user in a messaging session [Barrett, matching criteria col 6 lines 1-27].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Barrett et al [Barrett 6,400,381 B1] in view of Okada et al [Okada 6,363,461 B1].

7. As per claim 2, Barrett discloses the matching criteria is in the form [Barrett, a form, col 4 lines 9-19; Fig 4-5]. However Barrett does not detail the form of an **approval** indication by the first user of the reply comment.

In the same endeavor, Okada discloses a chat system with a desired form [Okada, desired form, col 2 lines 32-45] wherein an agent connected the server and the plurality of client workstations, the agent reads the records (or matching criteria) from the stored log file (or memory contains the comments) when the records match the previously stored conditions, then the connection is established (or approved), col 22 lines 30-62].

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to incorporate the matching record as an approval indication as

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taught by Okada into the Barrett's apparatus in order to utilize the chat form. Doing so would provide a speedy preparation of the record of chat room.

8. As per claim 3, Barrett-Okada disclose the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object [Barrett, Web pages, col 4 lines 53-65].

9. As per claim 4, Barrett-Okada disclose presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session [Barrett, a private chat line, col 5 lines 37-47. It was clearly that the first user created a private chat line and email to the second, third or subsequent users who provide the reply comments and connect to chat session].

10. As per claim 5, Barrett-Okada disclose the predetermined display count is a function of the popularity of the media object and the first user [Barrett, the first user opens a private chat line, col 5 lines 37-47].

11. As per claim 6, Barrett-Okada disclose the predetermined display count is a function of the popularity of the media object and the first user, such that the

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predetermined display count is lower for more popular media objects relative to less popular media objects and lower for more popular first users relative to less popular first users [Barrett, the web pages provide the chat room which is less popular than Web page participants, col 5 lines 15-47].

12. As per claim 7, Barrett-Okada disclose the predetermined display count is a function of a parameter settable by the first user [Barrett, predefined criteria, col 6 lines 1-27].

13. As per claim 8, Barrett-Okada disclose a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes [Barrett, the web pages accepted the users accesses over a hierarchical topic or menu, col 5 lines 37-47].

14. As per claim 9, Barrett-Okada disclose accepting an association from the first user associating the first comment with one of the nodes; and presenting users subsets of comments that are associated with a subset of the nodes [Barrett, grouping, col 6 lines 29-36].

15. As per claim 10, Barrett-Okada disclose limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node [Barrett, the place server defines communicating grouping of similar users, col 5 lines 49-65].

16. As per claim 11, Barrett-Okada disclose a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects as inherent features of private chat line.

17. As per claim 12, Barrett-Okada disclose a method, in a messaging server, of connecting parties with mutual interests, comprising the steps of:

presenting a media object to a plurality of users [Barrett, a chat window, col 5 lines 15-25];

accepting a first comment from a first one of the plurality of users [Barrett, the client applet identifies the user to the chat server, col 5 lines 1-15];

presenting the media object and the first comment to the plurality of users [Barrett, the chat from all of users of the communication grouping, col 5 lines 15-25];

accepting a reply comment from a second one of the plurality of users;
presenting the reply comment to the first user [Barrett, the chat from all of users of the communication grouping, col 5 line 15-col 6 line 28]; and

connecting the first and the second user in a messaging session if the first user indicates **approval** of the reply comment [Okada, the record which is in a desired form match to of the previously stored conditions, col 22 lines 30-62].

18. Claims 13-21 contains the similar limitations as the claims 3-11. Therefore claims 13-21 are rejected by the same rational set forth claims 3-11.

19. As per claim 22, Barrett-Okada disclose the media object includes a link to the first comment Barrett, a web page with URL, col 4 lines 39-52].

20. As per claims 23,25 Barrett-Okada disclose the second user selecting the link, wherein selection of the link provides a list of one or more comments including the first comment as inherent feature of private chat line.

21. As per claim 26, Barrett-Okada disclose the messaging session is an instant message session [Barrett, chat window, col 5 lines 15-25].

22. As per claim 27, Barrett-Okada disclose providing the first comment to the second user in response to a search inquiry entered by the second user [Barrett, a search engine, col 5 lines 49-65].

23. As per claim 28, Barrett-Okada disclose the search inquiry is a keyword search [Barrett, a search engine, col 5 lines 49-65].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished

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Thong Vu
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Thong Vu', with a stylized flourish at the end.